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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/921,016	08/03/2001	Glenn D. Austin	00717.00008	5841
22907	7590	06/14/2005	EXAMINER	
BANNER & WITCOFF 1001 G STREET N W SUITE 1100 WASHINGTON, DC 20001			BROWN, MICHAEL A	
			ART UNIT	PAPER NUMBER
			3764	

DATE MAILED: 06/14/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

<b>Office Action Summary</b>	<b>Application No.</b> 09/921,016	<b>Applicant(s)</b> AUSTIN ET AL.	
	<b>Examiner</b> Michael Brown	<b>Art Unit</b> 3764	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

#### Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

#### Status

- 1) ☒ Responsive to communication(s) filed on 22 March 2005.
- 2a) ☒ This action is **FINAL**.                      2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

#### Disposition of Claims

- 4) ☒ Claim(s) 1-33 and 36-42 is/are pending in the application.  
4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☒ Claim(s) 31, 32 and 36-39 is/are allowed.
- 6) ☒ Claim(s) 1-17, 22-28, 30-33, 40-42 is/are rejected.
- 7) ☒ Claim(s) 18-21 and 29 is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

#### Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

#### Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).  
a) ☐ All    b) ☐ Some \*    c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
  2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

#### Attachment(s)

- |  |   |
|--|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892)   | 4) <input type="checkbox"/> Interview Summary (PTO-413)<br>Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)                                   | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152)             |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)<br>Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____  |

## DETAILED ACTION

### *Claim Rejections - 35 USC § 102*

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(e) the invention was described in a patent granted on an application for patent by another filed in the United States before the invention thereof by the applicant for patent, or on an international application by another who has fulfilled the requirements of paragraphs (1), (2), and (4) of section 371(c) of this title before the invention thereof by the applicant for patent.

The changes made to 35 U.S.C. 102(e) by the American Inventors Protection Act of 1999 (AIPA) and the Intellectual Property and High Technology Technical Amendments Act of 2002 do not apply when the reference is a U.S. patent resulting directly or indirectly from an international application filed before November 29, 2000. Therefore, the prior art date of the reference is determined under 35 U.S.C. 102(e) prior to the amendment by the AIPA (pre-AIPA 35 U.S.C. 102(e)).

Claims 1, 4-5, 9, 13-15, 17, 22, 26, 30 and 33 are rejected under 35 U.S.C. 102(e) as being anticipated by Kassman.

Kassman discloses in figure 12 a tubular pouch 78 or resilient membranous material (elastomers), having an open end (fig. 12), a closed end (fig. 12), an external biasing member 84, an internal biasing member 104 in an intermediate portion of the tubular pouch, the internal biasing member is a circular ring (fig. 12), the second biasing member includes a second ring (84 is a ring), the first ring is generally concentric with the second ring with respect to the longitudinal axis of the condom (fig. 12), the internal biasing member includes a plurality of stays 102 that is a resilient framework (fig. 12)

the framework includes a plurality of elements 102, the internal biasing member includes a pad (104 provides a resilient pad) and the external biasing member includes a second ring 96. The first ring has a generally oval shape (fig. 12). The internal biasing member forms a recess (the opening below the internal biasing member inside of the condom towards the closed end).

***Claim Rejections - 35 USC § 103***

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

Claims 2-3, 6-8 10-12, 27 and 41-42 are rejected under 35 U.S.C. 103(a) as being unpatentable over Kassman in view of Applicant provided prior art.

Kassman discloses in figure 12 a female condom, substantially as claimed. However, Kassman does not disclose what the untensioned distance is between the two biasing members or the diameter of the inner ring. It would have been obvious to one having ordinary skill in the art at the time that the untensioned distance between the first and second biasing members could be the same distance recited in the claims of the present invention because the distance is not critical and lack novelty over the prior art. The aspect ration of the oval ring does not provide patentability over the prior art. It is old and well known in the art to roll a condom upon a ring (biasing element) before use in order to place it on the male's penis. Applicant prior art in figure 1 shows a condom having a proximal portion with an hourglass shape.

Claim 16 is rejected under 35 U.S.C. 103(a) as being unpatentable over Kassman in view of Bellak.

Kassman discloses in figure 12 a female condom, substantially as claimed. However, Kassman does not disclose the framework including a helical element. Bellak teaches in figure 1 a condom comprising a helical element 17. It would have been obvious to one having ordinary skill in the art at the time that the invention was made that the helical element as taught by Bellak could be incorporated into the condom disclosed by Kassman in order to assist in holding the condom inside of the female.

Claims 22-25 are rejected under 35 U.S.C. 103(a) as being unpatentable over Kassman in view of Couvreur.

Kassman discloses in figure 12 a condom, substantially as claimed. However, Kassman does not disclose the internal biasing member being a pad of foam. Couvreur teaches in figure 1 a female condom comprising an internal biasing member 45 that is made of foam. It would have been obvious to one having ordinary skill in the art at the time that the invention was made that the second biasing member disclosed by Kassman could be a pad of foam as taught by Couvreur because either retaining device could be used to assist in holding the condom inside of the vagina. The foam could be hydrophilic, or polyurethane.

Claim 28 is rejected under 35 U.S.C. 103(a) as being unpatentable over Kassman in view of Papurt.

Kassman discloses in figure 12, a female condom, substantially as claimed. However, Kassman does not disclose the second biasing member having an

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indentation. Papurt teaches in figure 1 an external biasing member 17 that has indentations fig.2. It would have been obvious to one having ordinary skill in the art at the time that the invention was made that the indentations as taught by Papurt could be incorporated into the biasing member disclosed by Kassman in order to use the indentations as a grasping tool.

Claim 40 is rejected under 35 U.S.C. 103(a) as being unpatentable over Spery in view of Kassman.

Spery discloses in figures 1-7 an assembly, substantially as claimed. However, Spery does not disclose a second biasing member. Kassman teaches in figure 12 a second biasing member, as set forth above. It would have been obvious to one having ordinary skill in the art at the time that the invention was made that the second biasing member as taught by Kassman could be incorporated into the condom disclosed by Spery to assist in holding the condom inside of the vagina.

### ***Allowable Subject Matter***

Claims 18-21 and 29 are objected to as being dependent upon a rejected base claim, but would be allowable if rewritten in independent form including all of the limitations of the base claim and any intervening claims.

Claims 31-32 and 36-39 are allowed.

### ***Response to Arguments***

Applicant's arguments filed March 22, 2005 have been fully considered but they are not persuasive. Applicant argues that the prior art doesn't disclose the proximal pouch portion tenting against the introitus in the general shape of an hour-glass when the condom is inserted in the vagina. However, the hour-glass shape is not positively claimed. Thus, whether the internal biasing means in the proximal pouch portion takes on the shape of an hour-glass wasn't given patentable weight. As discussed during the interview the internal biasing means must be positively claimed in order to give patentable weight to the shape.

### ***Conclusion***

**THIS ACTION IS MADE FINAL.** Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire **THREE MONTHS** from the mailing date of this action. In the event a first reply is filed within **TWO MONTHS** of the mailing date of this final action and the advisory action is not mailed until after the end of the **THREE-MONTH** shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than **SIX MONTHS** from the mailing date of this final action.

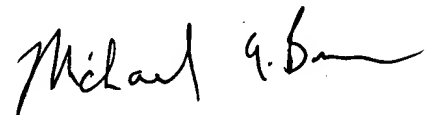
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Any inquiry concerning this communication or earlier communications from the examiner should be directed to Michael Brown whose telephone number is 703-308-2682. The examiner can normally be reached on 5:30 am-4:00 pm Monday-Friday.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Gregory Huson can be reached on 571-272-4887. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

M. Brown  
June 2, 2005

A handwritten signature in black ink, appearing to read "Michael A. Brown".

**MICHAEL A. BROWN**  
**PRIMARY EXAMINER**